



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|------------------------|---------------------|------------------|
| 10/587,653 | 12/08/2008 | Christopher Henry Such | 0446-0188PUS1 | 2764 |
| 2292 7590 11/02/2010 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747 | | | | |
| EXAMINER | | | | |
| MESH, GENNADIY | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1763 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 11/02/2010 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/587,653

Applicant(s)

SUCH ET AL.

Examiner

GENNADIY MESH

Art Unit

1763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6, 8, 9, 12, 15-18, 20, 21, 23, 24, 27, 30, 31, 34-37, 39-41 and 43-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-3, 5-6, 8-9, 12, 15-18, 20-21, 23-24, 27, 30-31, 34-37, 39-41 and 43-52 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- 1.1. Group (I), claim(s) 1-3, 5-6, 8-9, 12 and 15, drawn to Process for preparation of solid polyester granules by suspension polymerization in presence of diacyl peroxides and aromatic amine.
- 1.2. Group (II), claim(s) 16-18, 20-21, 23-24, 27, 30-31 and 34-36, drawn to Process for preparation of solid polyester granules, comprising step of preparing a solution of unsaturated polyester and combination of peroxides in styrene, wherein combination of peroxides comprising diaroyl and dialknoyl peroxides.
- 1.3. Group (III), claim(s) 37, drawn to Process for preparation of solid polyester granules, comprising step of preparing a solution of unsaturated polyester and combination of diacyl peroxides in styrene, wherein radical flux generated by first peroxide is greater than any radical flux generated by second peroxide.
- 1.4. Group (IV), claim(s) 39-41 and 43, drawn to water based decorative paint.
- 1.5. Group (V), claim(s) 44-52, drawn to Redox initiating system for use in Process

for preparation of solid polyester granules, comprising combination of diacyl peroxides and amine.

2. The inventions listed as Groups I-V lack unity of invention because even though the inventions of these groups require the technical feature as Redox initiating system comprising combination of diacyl peroxides and amine, this technical feature is not a special technical feature as it does not make a contribution over the prior art in view of Ritchie et al. (US 6,533,967 - reference cited by Applicant) combine with Kamath et al. (US 4,129,703 - reference cited by Applicant). Note, that Ritchie disclosed use of substantially same initiating system, comprising combination of identical amine and peroxide, wherein peroxide can be selected from variety of diacyl peroxide, but silent regarding use of more than one peroxide in process of preparation of solid polyester granules.

However, Kamath teaches, that free-radical polymerization of vinyl monomer (styrene) can be conducted in presence of at least two peroxides, wherein first peroxide effective at low temperature and second peroxide effective at higher temperature in order to reduce polymerization time (see abstract, column 1, lines 23- 58). Therefore, it would be obvious to use more than one peroxide in process disclosed by Ritchie as it taught by Kamath.

3. If one invention from **Groups I - III** is elected for prosecution on the merits, then additional requirement to elect single disclosed specie will apply.

3.1. This application contains claims directed to more than one species of the generic invention. These Species as Different method for producing Polyester in presence of different redox initiating system, comprising two different peroxides and amine.

Different method for producing Polyester in presence of **different** redox initiating system are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. (see paragraph 2 above).

- 3.2. Applicant is required, in reply to this action, to elect a single species as **Specific** method for producing Polyester in presence of **specific** redox initiating system, comprising two **specific peroxides** and amine.

The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise require all the limitations of an allowed generic claim. Currently, the following claim(s) are generic: For **Group I** - Claim 1; For **Group II** - Claim 16 and For **Group III** - Claim 37.

4. If invention of **Group (IV)** is elected for prosecution on the merits, then additional requirement to elect single disclosed specie will apply.
- 4.1. This application contains claims directed to more than one species of the generic invention. These Species as Different water based decorative **paint**, comprising polyesters granules prepared by different processes of claims 1, 16 or 37, comprising **different** redox initiating system, comprising two different peroxides

and amine.

Different water based **decorative paint**, comprising polyesters granules prepared by different processes of claims 1, 16 or 37, method for producing Polyester in presence of **different** redox initiating system are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. (see paragraph 2 above).

- 4.2. Applicant is required, in reply to this action, to elect a single species as **Specific decorative paint** comprising polyesters granules prepared by specific processes of claims 1, 16 or 37, comprising **specific** redox initiating system, comprising **two specific peroxides** and amine.

The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise require all the limitations of an allowed generic claim. Note, that for **Group IV** the following claim(s) is generic: Claim 39.

5. If invention of **Group (V)** is elected for prosecution on the merits, then additional requirement to elect single disclosed specie will apply.
- 5.1. This application contains claims directed to more than one species of the generic

invention. These Species as **Different** redox initiating system, comprising comprising two **different peroxides** and amine.

Different redox initiating system are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. (see paragraph 2 above).

- 5.2. Applicant is required, in reply to this action, to elect a single species as **Specific redox initiating system** comprising **two specific peroxides** and amine.

The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise require all the limitations of an allowed generic claim. Note, that for **Group V** the following claim(s) is generic: Claim 44.

5. A telephone call was made to Mary Anne Armstrong on October 12, 2010 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention or species.

Should applicant traverse on the ground that the inventions have unity of invention (37 CFR 1.475(a)), applicant must provide reasons in support thereof. Applicant may submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. Where such evidence or admission is provided by applicant, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GENNADIY MESH whose telephone number is (571)272-2901. The examiner can normally be reached on 10 a.m - 6 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272 1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Milton I. Cano/
Supervisory Patent Examiner, Art Unit 1763

Gennadiy Mesh
Examiner
Art Unit 1763

/GM/